

### REMARKS

The Official Action dated February 20, 2004, has been carefully considered. Accordingly, the changes and remarks presented herewith are believed sufficient to place the present invention in condition for allowance. Reconsideration is respectfully requested.

Claim 25 has been amended. Since this amendment does not involve any introduction of new matter, entry is believed to be in order and is respectfully requested.

In the Official Action, the Examiner rejected claim 25 under 35 U.S.C. §112, first paragraph, as containing subject matter which is not described in the specification in such a way to reasonably convey to one skilled in the art that the inventors at the time the application was filed had possession of the claimed invention. Claim 25 has been amended. Page 12, lines 11-27 of the specification clearly provides support for the limitations of the claimed invention as defined by claim 25 to reasonably convey to one skilled in the art that the inventor at the time of the application had possession of the claimed invention. As such, the rejection under 35 U.S.C. §112, first paragraph, has been overcome. Reconsideration is respectfully requested.

In the Official Action, the Examiner rejected claims 15-17, 20-23 and 25 under 35 U.S.C. §103(a) as being unpatentable over Colbert et al. (U.S. Patent No. 5,699,494) in view of Yamazoe et al. (U.S. Patent No. 6,628,825). Note: In the Official Action, the Examiner cited 35 U.S.C. §102(b) for the rejection. However, Applicants believe that this is a typographical error and that the Examiner intended to cite 35 U.S.C. §103(a). As such, the following response is directed to a rejection under 35 U.S.C. §103(a). The Examiner asserted that Colbert et al. teach a method for diagnosing a printer, including the steps of: establishing a communication link between the stand-alone printer and the computer, receiving instructions from the computer at the stand-alone printer, and diagnosing one or more functions of the stand-alone printer in accordance with the received instructions, wherein the stand-alone printer is capable of processing and printing digital files acquired by

an external device independent of an external host device. The Examiner conceded that Colbert et al. do not teach or disclose that the printer is capable of processing and printing digital photographs having a photographic format. The Examiner asserted that Yamazoe et al. teach a printer used in a general user's home connected to the user's computer that can be used to print photographs having a photographic format. The Examiner asserted it would have been obvious to a person of ordinary skill in the art to have modified the print system of Colbert et al. to include using the printer of Colbert et al. to process and print digital photographs having a photographic format.

However, as will be set forth in detail below, it is submitted that the methods for diagnosing a stand-alone printer set forth by claims 15-17, 20-23 and 25 are nonobvious and patently distinguishable from Colbert et al. in view of Yamazoe et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

Claim 15, from which claims 16-17, 20-23 and 25 depend, is directed toward a method for diagnosing a stand-alone printer. The method includes the steps of establishing a communication link between the stand-alone printer and a computer; receiving instructions from the computer at the stand-alone printer via the communication link; and diagnosing one or more functions of the stand-alone printer in accordance with the received instructions. The stand-alone printer is capable of processing and printing digital photographs, acquired by an external device, independent of an external host device.

Colbert et al., on the other hand, disclose a remote replication of an operator panel of a conventional printer on a host computer to which the printer is connected (either locally or by way of a network). The host computer is provided with access to a visual and functional replica of the operator panel of the printer, such that the user of the host computer may view the replica at the site of the host computer. According to Colbert et al., a user of the host computer can, for example, view and use an operator panel of a remote printer that is either

located where it is not readily physically accessible or is obscured from the view of a user of a given host.

Among other limitations, claim 15 requires, for example, diagnosing one or more functions of a "stand-alone printer" in accordance with instructions received at the stand-alone printer via a communication link between the stand-alone printer and a computer. Colbert et al. simply fail to teach or suggest anything with respect to a stand-alone printer. The Examiner asserted in the rejection that the printer 16 in Fig. 1 of Colbert et al. is a stand-alone printer. However, Applicants find no teaching or suggestion that the conventional printer 16 in Fig. 1 is a stand-alone printer as required by claim 15. For example, as presently claimed, a "stand-alone printer" is a printer capable of processing and printing digital photographs, acquired by an external device, independent of an external host device.

In direct contrast, the remote printer 16 of Colbert et al., appears to be dependent on an external host computer 11 to process digital files (e.g., it uses a printer driver running within an operating environment running on a host computer 11 to transcribe a print job into postscript format that can be interpreted by the printer 16). In fact, since Colbert et al. is directed for allowing a user of an external host computer to view and use an operator panel of a non-accessible or obscured remote printer, modifying such a non-accessible or obscured printer to make it stand-alone would further seem to be counter intuitive. The Examiner has claimed that Colbert et al. teach a stand-alone printer because the print job would be rasterized without the help of a host computer. However, Applicants note that the print job in Colbert et al. must "be received in one or more printer control languages" for the conventional printer 16 to rasterize and serialize the data (See column 9, lines 55-56). Moreover, Applicants find no teaching or suggestion that the conventional printer 16 in Fig. 1 is a stand-alone printer that is capable of processing and printing digital photographs, acquired by an external device, independent of an external host device, wherein the digital

photographs are stored in conventional photographic formats such as “.tiff”, “.jpg” and “.gif” and are not in a printer control language.

The Examiner has conceded that Colbert et al. do not teach, disclose or suggest that the printer is capable of processing and printing digital photographs having a photographic format. The Examiner apparently is relying on the system of Yamazoe et al. for teaching a stand-alone printer that is capable of processing and printing digital photographs, acquired by an external device, independent of an external host device.

Yamazoe et al. disclose an image processing method and apparatus for correcting color fog when printing photographic images. Yamazoe et al., like Colbert et al., is dependent on an external host computer to process digital files (e.g., it uses a printer driver running within an operating environment running on a host computer to transcribe a print job into postscript format that can be interpreted by the printer). The method and apparatus for correcting color is a print driver application running on the operating system of the host computer connected to the printer. (See Col. 3, lines 65 to Col. 4 line 43). There is no teaching or suggestion by Yamazoe et al. of the printer being capable of processing and printing digital photographs, acquired by an external device, **independent of an external host device**. In fact, Yamazoe et al. teach the exact opposite, in that the processing of the digital photographs is performed by the printer driver on the host computer (See Col. 4, lines 24-43).

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974). Applicants find no teaching or suggestion by Colbert et al. and Yamazoe et al., alone or in combination, of a stand-alone printer that is capable of processing and printing digital photographs, acquired by an external device, independent of an external host device. The printers disclosed by both Colbert et al. and Yamazoe et al. require an

external host device to process and print digital photographic images. Moreover, when a rejection depends on the combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. *In re Rouffet*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998). The question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness of making the combination. *In re Beattie*, 974 F.2d 1309, 1311-1312, 24 U.S.P.Q.2d 1040, 1042 (Fed. Cir. 1992). Applicants find no teaching, suggestion or motivation for the combination of Colbert et al. and Yamazoe et al. In fact, Yamazoe et al. teach away from the Examiner's suggested combination. The printer disclosed by Yamazoe et al. is not a stand-alone printer. As explicitly stated in Yamazoe et al. (Col. 3, lines 65 - Col. 4, line 10), the printer is connected to a host computer on which the printer driver calculates and processes the photographic image to prepare the print data. The presently claimed invention requires a stand-alone printer that is capable of processing and printing digital photographs, acquired by an external device, independent of an external host device. There would be no motivation or suggestion to utilize the printer of Yamazoe et al. as it teaches away from the present invention by requiring a host computer to calculate and process the photographic images for printing.

Finding no teaching or suggestion in Colbert et al. and Yamazoe et al., alone or in combination, of diagnosing a "stand-alone printer", Colbert et al. and Yamazoe et al. fail to teach or suggest the methods for diagnosing a stand-alone printer, as currently defined by claims 15-17, 20-23 and 25. Therefore, Colbert et al. and Yamazoe et al. do not render the presently claimed invention obvious. Whereby, the rejection has been overcome and reconsideration is respectfully requested.

As noted in the prior Response, the present application in addition to being allowable as being based on allowable independent claim 15, claims 16 and 17, which depend on claim 15, include additional limitations which are not found in Colbert et al. and Yamazoe et al.

For example, claim 16 requires the received instructions comprise content to be presented on a display of the stand-alone printer. Although the Examiner asserts that Colbert et al. (column 10, line 39) teach the limitation, further examination of this portion shows that what is being discussed is merely what content is being displayed. There is simply no teaching with respect to such content being received at the printer in the form of instructions. In fact, further reference to Colbert et al. shows that it teaches that the printer 16, rather than the host computer 11, determines content to be presented (see column 24, lines 18-27), and teaches that this is significant (e.g., because it provides a true response of printer 16 to control actions initiated through the replica). Accordingly, if anything, Colbert et al. teaches replicating on a host computer content already presented on the display of a remote printer.

Meanwhile, claim 17 requires processing user inputs to the stand-alone printer by the computer. One advantage such a method could include allowing the diagnostic functionality to be added without using much of the responses of the stand-alone printer. Although the Examiner cites to column 13, lines 15-35, and column 10, lines 1-40, as purportedly supporting this position, the discussion of flags in column 13 does not appear to have anything to do with user inputs (it appears to deal with printer conditions), while the discussion in column 10 merely describes what the printer can do. Neither have anything to do with the computer processing user inputs to a stand-alone printer. In fact, Colbert et al., appears to teach just the opposite (e.g., in column 10, lines 45-55 and column 23, lines 65-67, it appears to teach that a printer state manager 140 operating via controller 72 of printer 16 processes commands corresponding to user inputs to the printer).

Accordingly, as Colbert et al. and Yamazoe et al. fail to teach or suggest every limitation of claims 16 and 17, Colbert et al. and Yamazoe et al. fail to render those claims obvious. Therefore, the rejection of claims 16 and 17 has been overcome. Reconsideration is respectfully requested.

In the Official Action, claims 1-6, 9 and 11-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Satomi et al. (U.S. Patent No. 4,759,053) in view of Batten et al. (U.S. Patent No. 6,417,937). The Examiner asserted that Satomi et al. teach a printer configuration comprising: a) a computer readable medium comprising data; b) a computer having access to the data on the computer readable medium; c) a communication link connected to the computer; d) a printer connected to the communication link and in communication with the computer, the printer having a selection mechanism and having access to the data over the communication link in response to a user's input to the selection mechanism on the printer. The Examiner conceded that Satomi et al. fail to teach or disclose that the printer is a photoprinter.

Apparently because of the deficiencies of Satomi et al., the Examiner asserted that Batten et al. teach a facsimile equipment/machine that inherently prints an image of a photograph by using the reader/scanner of the facsimile equipment/machine to transform an optical image of a photograph into electrical signals suitable for storing, displaying, processing by a computer, transmitting and printing. The Examiner asserted it would have been obvious to have modified the facsimile equipment of Satomi et al. to include reading a photograph, transmitting the read photograph to the computer, and receiving the transmitted read photograph from the computer for printing.

However, as will be set forth in detail below, it is submitted that the printer configurations and methods for accessing digital photographs defined by claims 1-6, 9 and 11-13 are non-obvious and patentably distinguishable from Satomi et al. in view of Batten et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

To establish *prima facie* obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974). Moreover, in order for references to be relied upon to support a

rejection under 35 U.S.C. § 103 they must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *Glaxo Inc. v. Novopharm Ltd.*, 34 U.S.P.Q.2d, 1565 (Fed. Cir. 1995); *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979). Neither Satomi et al. nor Batten et al., whether alone or independently, satisfy these requirements.

As defined by claim 1, the present invention relates to a printer configuration. The printer configuration comprises: a computer readable medium comprising data; a computer having access to the data on the computer readable medium; and a photoprinter in communication with the computer via a communication link, the photoprinter having a selection mechanism and having access to the data over the communication link in response to a user's input to the selection mechanism, wherein the photoprinter is a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device.

As defined by claim 11, the present invention relates to a printer configuration. The printer configuration comprises: a computer having a plurality of digital photographs on a computer readable medium; and a photoprinter communicating with the computer via a communication link, the photoprinter having means for accessing the digital photographs, wherein the photoprinter is a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device.

As defined by claim 12, the present invention relates to a method of accessing digital photographs on a computer. The method comprises: establishing a communication link between a photoprinter and the computer; receiving a request at the photoprinter from a user; and accessing the digital photographs with the photoprinter in response to the request, wherein the photoprinter is a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device.



Meanwhile, Satomi et al. disclose a facsimile/character communication system capable of transmitting or receiving character data through a host computer intermediately storing the character or picture data. Batten et al. discloses an automatic document feeder and active transparency adapter for a scanner. As noted by the Examiner, Satomi et al. fail to teach, disclose or suggest a photoprinter.

Applicants find no teaching or suggestion in Batten et al. of a photoprinter, as defined and required by claims 1, 11 and 12. The Examiner asserted that Batten et al. teach a facsimile equipment/machine that inherently prints an image of a photograph. However, as defined by the claims 1, 11 and 12, a “photoprinter” is a printer capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device. Neither Batten et al. nor Satomi et al. disclose or teach a printer capable of such functionality.

In view of the failure of Satomi et al. and Batten et al., alone or in combination, to teach, disclose or suggest a photoprinter as defined by claims 1, 11 and 12, Satomi et al. and Batten et al. do not render the presently claimed printer configurations and methods obvious. It is therefore submitted that the presently claimed printer configurations and methods are non-obvious over and patentably distinguishable from Satomi et al. in view of Batten et al., whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

In the Official Action, claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over Satomi et al. in view of Batten et al. and further in view of Foth (U.S. Patent No. 6,473,498). The Examiner conceded that Satomi et al. do not teach wherein the computer is connected locally to the photoprinter. The Examiner asserted that Foth teaches connecting a computer to a facsimile machine by using an RS232 cable. The Examiner asserted that it would have been obvious to a person of ordinary skill in the art to modify

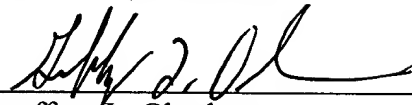
Satomi et al./Batten et al.'s photoprinter to include the computer being locally connected to the facsimile machine of the photoprinter. However, as will be set forth in detail below, it is submitted that the printer configuration of claim 7 is non-obvious and patentably distinguishable over the teachings of Satomi et al. in view of Batten et al. and in further view of Foth.

As defined by claim 7, the present invention is directed towards a printer configuration of claim 1, wherein the computer is connected locally to the photoprinter. The teachings of Satomi et al. in view of Batten et al. are discussed above. The deficiencies of Satomi et al. in view of Batten et al. are not overcome with the combination of Foth. Moreover, Foth alone or in combination with Satomi et al. and Batten et al., fail to teach or suggest a printer configuration wherein the computer is connected locally to the photoprinter.

Foth discloses a system for utilizing a single incoming/outgoing line to transmit and receive data through a variety of devices. While Foth discloses that a computer may be connected to a facsimile machine, Applicants find no teaching or suggestion by Foth of a photoprinter, as defined and required by claims 1, 11 and 12. It is therefore submitted that the presently claimed printer configuration is non-obvious over and patentably distinguishable from Satomi et al. in view of Batten et al. and further in view of Foth, whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

It is believed that the above represents a complete response to the Examiner's rejections under 35 U.S.C. §§102, 103 and 112 and places the present invention in condition for allowance. Reconsideration and an early allowance are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'G. L. Oberhaus', written over a horizontal line.

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